

**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL TO THE BOARD OF APPEALS**

In re Application of: Steven R. Placek)
Serial N°: 10/806,859)
Filed: 03/23/2004)
For: **Adjustable Boat Platform Insert**)

Date: March 14, 2006
Group Art Unit: 3617
Examiner: Swinehart, Edwin L.

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BOARD OF APPEALS
AND INTERFERENCES

CERTIFICATE OF SERVICE

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Name:

Terry Lakos
Terry Lakos

Date

3/15/06

REPLY

This is a reply to the Answer received on 07/01/2005.

In appear, as previously described, the Examiner has made a combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight. This is insufficient to present a prima facie case of obviousness. In re Oetiker, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992) There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 30 USPQ 2d 1377, 1379-80 (Fed. Cir. 1994).

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When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination. In re Ichihashi, Civ. App. No. 93-1172, slip op. at 2-3 (Fed. Cir. Sep. 9, 1993) (unpublished)

In the absence of some evidence of the level of ordinary skill, including evidence tending to show what one of such ordinary skill would be motivated to accomplish in view of the cited prior art, the board may not rest a prima facie case only on its own unsupported assertions. Swede Industries v. Zebco Corp., Civ. App. No. 93-1403, slip op. at 4-5 (Fed. Cir. April 12, 1994) (unpublished)

It is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103, in addition to any other art, relevant or not, is also inappropriate. Additionally, there is no indication as to the motivation for combining those known element that may appear in the present invention.

Accordingly, the reversal of the Examiner by the honorable Board of Appeals is respectfully solicited.

Respectfully submitted,

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